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| EXAMINER |
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MADAMBA, GLENFORD J

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| ART UNIT | PAPER NUMBER |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/707,435

Applicant(s)

SWINTON, WILLIAM G.

Examiner

Glenford Madamba

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks and Amendments

1. This action is in response to remarks and claim amendments filed by Applicant's representative on November 1, 2007.
2. Applicant's remarks and claim amendments filed on November 1, 2007 have been considered but are now moot in light of the new grounds of rejection provided with this action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-19, 22-49 and 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyhalammi et al (hereinafter Pyhalammi), U.S. Patent Publication US

2005/0091367 A1 in view of Zuidema et al (hereinafter Zuidema), U.S. Patent
Publication US 2006/0031297 A1.

As per Claims 1, 29, 30 and 31, Pyhalammi in view of Zuidema discloses in a messaging system, a method for restoring media items to original quality, the method comprising:

upon receipt of a message containing an original media item that is new, storing the original media item (202 and 204) in a repository (306) [Figs. 2 & 3] [0043];

generating an identifier for identifying the original media item stored in the repository (embedding / associating a digital watermark with the content 202) [Fig. 2] [0010] (e.g., subscriber identity, thumbnail image, or filename for the image/thumbnail image) [0039];

replacing the original media item in the message with a lower quality substitute copy that includes said identifier (e.g., transmission/retransmission of "watermarked content") [Fig. 3] [0010-0011] (e.g., watermarked image 922a) [0063] [0070], and

upon future encounter of a particular media item having said identifier, restoring the particular media item to the original quality using said identifier [0062-0065].

While Pyhalammi discloses substantial features of the invention such as the method of claim 1, and the method wherein the object reference identifier is embedded

in a header for the JPEG image (i.e., indicator / watermark may be in the header) [0069], the additionally recited feature of the method wherein the original media item in the message with a lower quality substitute copy that includes said identifier is expressly disclosed by Zuidema in a related endeavor.

Zuidema discloses as his invention a system for and method of controlling retransmission of a content item contained in a multimedia message. The method comprises: receiving the message containing the content item from a sender together with an identifier of an intended recipient of the message, processing the content item to detect the presence or absence of a watermark therein, if the absence of a watermark has been detected, causing a watermark to be embedded in the content item, and allowing retransmission of the message including the watermarked content item to the intended recipient, and otherwise controlling retransmission of the message including the content item to the intended recipient [Abstract]. In particular, Zuidema discloses the additional recited feature of the method wherein the original media item in the message with a lower quality substitute copy that includes said identifier [Zuidema: 00280035].

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Pyhalammi's invention with the above said additional feature, as disclosed by Zuidema, for the motivation of providing a method of 'controlling' retransmission of a content item (e.g., images) contained in a multimedia message, including tracking of 'forwarded content', charging a fee for the

retransmission, restricting forwarding of the watermarked content item or disallowing the retransmission [Abstract] [0001] [0009-012].

Claim 29, 30 and 31 recites the same limitations as claim 1, is distinguished only by statutory category, and thus rejected on the same basis.

As per Claims 2 and 32, Pyhalammi discloses the method of claim 1, wherein said original media item comprises a component in user-composed messages (e.g., digital image) [0031].

As per Claims 3 and 33, Pyhalammi discloses the method of claim 1, wherein said messaging system comprises Multimedia Messaging Service (MMS) [0003].

As per Claims 4 and 34, Pyhalammi discloses the method of claim 1, wherein said replacing step includes:

using an available data communications channel that exists for encoding said original media item, in order to encode said identifier (e.g., encoded data) [0061].

As per Claims 5 and 35, Pyhalammi discloses the method of claim 1, wherein said restoring step includes:

as the message containing the substitute copy passes through a switching center (i.e., MMSC 710) [0010-0011] [Fig. 7], restoring the particular media item to original

quality by the switching center using the identifier to obtain the original media item stored in the repository [0062-0065].

As per Claims 6 and 36, Pyhalammi discloses the method of claim 1, wherein said restoring step includes: restoring the particular media item back to a first generation copy (original image 802) [0062].

As per Claims 7 and 37, Pyhalammi discloses the method of claim 1, wherein said messaging system comprises a message switch-based system [Fig. 4].

As per Claims 8 and 38, Pyhalammi in view of Zuidema discloses the method of claim 1, wherein said messaging system is able to allow transmission of a given media item in its original quality or decimate the given media item, as required for a given destination.

While Pyhalammi discloses substantial features of the invention such as the method of claim 1, and the importance of maintaining media object resolution quality such as when an image is 'resized' and retransmitted, he does not explicitly disclose the added feature of the method wherein said messaging system is able to allow transmission of a given media item in its original quality or decimate the given media item, as required for a given destination. The feature is disclosed by Zuidema in a related endeavor.

Zuidema discloses as his invention a system for and method of controlling retransmission of a content item contained in a multimedia message. The method comprises: receiving the message containing the content item from a sender together with an identifier of an intended recipient of the message, processing the content item to detect the presence or absence of a watermark therein, if the absence of a watermark has been detected, *causing a watermark to be embedded in the content item, and* allowing retransmission of the message including the watermarked content item to the intended recipient, and otherwise controlling retransmission of the message including the content item to the intended recipient [Abstract]. In particular, Zuidema discloses the additional recited feature of the method wherein said messaging system is able to allow transmission of a given media item in its original quality or decimate the given media item, as required for a given destination [Zuidema: 0028] [0035] [0042].

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Pyhalammi's invention with the above added feature, as disclosed by Zuidema, for the motivation of providing a method of 'controlling' retransmission of a content item (e.g., images) contained in a multimedia message, including tracking of 'forwarded content', charging a fee for the retransmission, restricting forwarding of the watermarked content item or disallowing the retransmission [Abstract] [0001] [0009-012].

As per Claims 9 and 39, Pyhalammi discloses the method of claim 1, wherein the message containing an original media is received from a mobile terminal [Fig. 4].

As per Claims 10 and 40, Pyhalammi discloses the method of claim 9, wherein the mobile terminal communicates via a multimedia messaging protocol .

As per Claims 11 and 41, Pyhalammi discloses the method of claim 1, wherein said identifier comprises an object reference identifier (e.g., subscriber identity, thumbnail image, or filename for the image/thumbnail image) [0039].

As per Claims 12 and 42, Pyhalammi discloses the method of claim 11, wherein said object reference identifier is capable of being embedded in the particular media item.

As per Claims 13 and 43, Pyhalammi discloses the method of claim 12, wherein the object reference identifier is embedded in a header of the particular media item (i.e., embedding data into content) [0010].

As per Claims 14 and 44, Pyhalammi in view of Zuidema discloses the method of claim 13, wherein said particular media item comprises a JPEG image, and wherein the object reference identifier is embedded in a header for the JPEG image (i.e., indicator / watermark may be in the header) [0069].

While Pyhalammi discloses substantial features of the invention such as the method of claim 1, and the method wherein the object reference identifier is embedded in a header for the JPEG image (i.e., indicator / watermark may be in the header) [0069], he does not explicitly disclose the additional feature of the method wherein said particular media item comprises a JPEG image. The feature is disclosed by Zuidema in a related endeavor.

Zuidema discloses as his invention a system for and method of controlling retransmission of a content item contained in a multimedia message. The method comprises: receiving the message containing the content item from a sender together with an identifier of an intended recipient of the message, processing the content item to detect the presence or absence of a watermark therein, if the absence of a watermark has been detected, *causing a watermark to be embedded in the content item, and* allowing retransmission of the message including the watermarked content item to the intended recipient, and otherwise controlling retransmission of the message including the content item to the intended recipient [Abstract]. In particular, Zuidema discloses the additional recited feature of the method wherein said particular media item comprises a JPEG image [Zuidema: 0035].

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Pyhalammi's invention with the above added feature, as disclosed by Zuidema, for the motivation of providing a method of 'controlling' retransmission of a content item (e.g., images) contained in a multimedia message, including tracking of 'forwarded content', charging a fee for the

retransmission, restricting forwarding of the watermarked content item or disallowing the retransmission [Abstract] [0001] [0009-012].

As per Claims 15 and 45, Pyhalammi discloses the method of claim 1, wherein the identifier is embedded in the substitute copy as a binary text string (i.e., binary / text) [0062].

As per Claims 16 and 46, Pyhalammi discloses the method of claim 15, wherein the binary text string contains sufficient information to allow retrieval of a copy of the original media item stored in the repository (e.g., registration / count value) [0069] [0080] (i.e., "Top Ten" content) [0034] [Fig. 6].

As per Claims 17 and 47, Pyhalammi discloses the method of claim 1, wherein the identifier employed for the particular media item depends on the particular media item's type [0039].

As per Claims 18 and 48, Pyhalammi discloses the method of claim 1, wherein said restoring step includes: scanning incoming media items for any preexisting identifiers (e.g., 'monitoring' / detecting embedded digital watermarks) [0040].

As per Claims 19 and 49, Pyhalammi discloses the method of claim 18, further comprising: if an incoming media item does not have a preexisting identifier, assigning a new identifier for that incoming media item (302, 304) [Fig. 3].

As per Claims 22 and 52, Pyhalammi discloses the method 22. The method of claim 1, wherein the identifier is embedded in a digital watermark employed for the particular media item (Watermarked Images 922a-b) [Fig. 9].

As per Claims 23 and 53, Pyhalammi discloses the method of claim 1, wherein said particular media item comprises an image, and wherein the identifier is embedded in a digital watermark for the image (Watermarked Images 922a-b) [Fig. 9].

As per Claims 24 and 54, Pyhalammi discloses the method of claim 1, wherein the identifier is embedded in a digital watermark for the substitute copy, said identifier be embedded as a binary text string (i.e., binary / text) [0062].

As per Claims 25 and 55, Pyhalammi discloses the method of claim 1, wherein steps of the method are performed at a server computer that connects to mobile terminals [Fig. 4].

As per Claims 26 and 56, Pyhalammi discloses the method of claim 1, wherein at least some steps of the method are performed at mobile terminals, for providing distributed processing [Figs. 1, 4, 7 & 12].

As per Claims 27 and 57, Pyhalammi discloses the method of claim 1, wherein said message is transmitted via the Internet from a client device to a server (Internet 1214) [Fig. 12].

As per Claims 28 and 58, Pyhalammi discloses the method of claim 27, wherein the client device connects to the Internet via wireless connectivity [Figs. 1, 4, 7 & 12].

3. Claims 20-21 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyhalammi et al (hereinafter Pyhalammi), U.S. Patent Publication US 2005/0091367 A1 in view of Rhoads et al (hereinafter Rhoads), U.S. Patent 6,522,769.

As per Claims 20 and 50, Pyhalammi in view of Rhoads discloses the method of claim 1, further comprising: removing from the repository any media item that is stale.

While Pyhalammi discloses substantial features of the invention such as the method of claim 1, and the method wherein the object reference identifier is embedded

in a header for the JPEG image (i.e., indicator / watermark may be in the header) [0069], he does not explicitly disclose the additional feature of the method further comprising removing from the repository any media item that is stale. The feature is disclosed by Rhoads in a related endeavor.

Rhoads discloses as his invention a system and method for reconfiguring a watermark detector. In many applications, it is useful to be able to change the operation of a watermark detector. Such changes may include changing how the watermark detector decodes or interprets a watermark embedded in a signal of a given media type, such as audio, video or still images [Abstract]. In particular, Rhoads discloses the additional recited feature of the method further comprising removing from the repository any media item that is stale (e.g., expiration of watermark "date field") [Rhoads: col 6, L66 – col 7, L14].

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Pyhalammi's invention with the above added feature, as disclosed by Rhoads, for the motivation of providing a system and method that allows reconfiguration of a watermark detector, and in particular, remote reconfiguration of the detector [col 1, L41-63].

As per Claims 21 and 51, Pyhalammi in view of Rhoads discloses the method of claim 20, wherein said removing step includes applying an aging mechanism to determine media items that are stale.

While Pyhalammi discloses substantial features of the invention such as the method of claim 1, and the method wherein the object reference identifier is embedded in a header for the JPEG image (i.e., indicator / watermark may be in the header) [0069], he does not explicitly disclose the additional feature of the method wherein said removing step includes applying an aging mechanism to determine media items that are stale. The feature is disclosed by Rhoads in a related endeavor.

Rhoads discloses as his invention a system and method for reconfiguring a watermark detector. In many applications, it is useful to be able to change the operation of a watermark detector. Such changes may include changing how the watermark detector decodes or interprets a watermark embedded in a signal of a given media type, such as audio, video or still images [Abstract]. In particular, Rhoads discloses the additional recited feature of the method wherein said removing step includes applying an aging mechanism to determine media items that are stale (e.g., expiration of watermark "date field") [Rhoads: col 6, L66 – col 7, L14].

It would thus be obvious to one of ordinary skill in the art at the time of the invention to combine and/or modify Pyhalammi's invention with the above added feature, as disclosed by Rhoads, for the motivation of providing a system and method that allows reconfiguration of a watermark detector, and in particular, remote reconfiguration of the detector [col 1, L41-63].

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.06(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenford Madamba whose telephone number is 571-272-7989. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Wallace Martin can be reached on 571-272-3440. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **JOHN FOLLANSBEE**
SUPERVISORY PATENT EXAMINER
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